



# Canadian Intellectual Property Office

## **THE REGISTRAR OF TRADEMARKS**

**Citation:** 2023 TMOB 119

**Date of Decision:** 2023-07-13

## **IN THE MATTER OF A SECTION 45 PROCEEDING**

**Requesting Party:** Curiouser Products, Inc.

**Registered Owner:** Nobal Technologies Inc.

**Registration:** TMA935879 for iMirror

### **INTRODUCTION**

[1] At the request of Curiouser Products, Inc (the Requesting Party), the Registrar of Trademarks issued a notice under section 45 of the Trademarks Act RSC 1985, c T-13 (the Act) on July 2, 2021, to Posh View Inc., the registered owner at that time of registration No. TMA935879 for the trademark iMirror (the Mark).

[2] The Mark is registered for use in association with the following goods: “Interactive digital display panel”.

[3] The notice required the registered owner to show whether the Mark was used in Canada in association with the goods specified in the registration at any time within the three-year period immediately preceding the date of the notice and, if not, the date

when it was last in use and the reason for the absence of use since that date. In this case, the relevant period for showing use is July 2, 2018 to July 2, 2021.

[4] The relevant definitions of use are set out in section 4 of the Act as follows:

4(1) A trademark is deemed to be used in association with goods if, at the time of the transfer of the property in or possession of the goods, in the normal course of trade, it is marked on the goods themselves or on the packages in which they are distributed or it is in any other manner so associated with the goods that notice of the association is then given to the person to whom the property or possession is transferred.

...

4(3) A trademark that is marked in Canada on goods or on the packages in which they are contained is, when the goods are exported from Canada, deemed to be used in Canada in association with those goods.

[5] In the absence of use, pursuant to section 45(3) of the Act, the registration is liable to be expunged, unless the absence of use is due to special circumstances.

[6] It is well established that the purpose and scope of section 45 of the Act is to provide a simple, summary and expeditious procedure for removing “deadwood” from the register. As such, the evidentiary threshold that the registered owner must meet is quite low [*Uvex Toko Canada Ltd v Performance Apparel Corp*, 2004 FC 448].

[7] Subsequent to the issuance of the notice, the Registrar recorded a change in title of the registration to Nobal Technologies Inc. (the Owner). This change is not at issue in the proceeding. Accordingly, references to the Owner below include its predecessor-in-title.

[8] In response to the Registrar’s notice, the Owner furnished the affidavit of William Roberts, sworn on September 3, 2021 (the Roberts Affidavit).

[9] Both parties submitted written representations and attended an oral hearing.

[10] As part of its written representations, the Owner submitted a “Supplementary Affidavit of William Roberts”, requesting that it be made of record. Per the Registrar’s letter dated January 27, 2022, the Owner’s request was denied and this second affidavit was not made of record as evidence in this proceeding. In this respect, *inter alia*, it has

been noted that there is no provision in the Act to file reply evidence in a section 45 proceeding [see *Gowling Lafleur Henderson LLP v Netlease Inc*, 2018 TMOB 33].

### **THE OWNER'S EVIDENCE**

[11] In his affidavit of record, Mr. Roberts states that he is the CEO of the Owner [para 1]. He explains that the Owner developed the iMirror digital display panel for use in retail outlets [para 6], referencing collaborations with Tommy Hilfiger stores and the True Fit Corporation [paras 6 and 7]. He states that the Owner “has now expanded into the hospitality industry” [para 10] and further that the Owner “is now selling and shipping its iMirror digital display panel worldwide” [para 11].

[12] Mr. Roberts closes his affidavit by asserting that the Owner “has used [the Mark] in the Relevant Period and continues to use [the Mark] in Canada” and that the Owner “has demonstrated use of [the Mark] in Canada during the Relevant Period” [paras 12 and 13].

[13] In support, the following exhibits are attached to the affidavit:

- Exhibit B is a photograph of what Mr. Roberts identifies as the iMirror digital display panel [para 5]. I note that the Mark is not visible anywhere on the depicted panel, including on the screen or on its frame.
- Exhibit C is a printout of an online CTV News article dated October 18, 2018 [para 6]. The article references the Owner’s two-year pilot project with Tommy Hilfiger and plans to install the iMirror panels in Tommy Hilfiger stores worldwide.
- Exhibit D is a printout of an April 2019 blog post from *truefit.com* [para 7]. The post references a partnership to integrate True Fit’s “Fashion Genome” with the Owner’s iMirror panels.
- Exhibit E is an undated photograph that Mr. Roberts identifies as “showing use of [the Mark] on the digital display panel in collaboration with the True Fit technology” [para 8]. The Mark is displayed on the panel’s screen.

- Exhibit F is a promotional brochure that Mr. Roberts states “is available to customers through [the Owner’s] direct sales force” [para 9]. The brochure appears to relate to the Owner’s products generally, not limited to the iMirror product. For example, the second page of the brochure includes the statement “iMirrors and iDisplays enable ‘Store of the Future’ experiences for consumers, today”, and the brochure also references iFIT, iSHOP and iBRAND products.
- Exhibit G is a screen shot from the Owner’s website [para 10], showing “iMIRROR” as a menu option.
- Exhibit H is an article from Alberta Innovates dated August 23, 2019 [para 11], that describes the history of the Owner and references sales of the iMirror panel in the U.S., Europe, and Dubai.

## **ANALYSIS**

[14] In its written representations, the Requesting Party notes various deficiencies in the Roberts Affidavit, submitting that the evidence does not demonstrate use of the Mark in Canada, nor special circumstances excusing non-use of the Mark [paras 13 to 23]. In particular, the Requesting Party notes the absence of evidence of even a single sale of the goods in Canada during the relevant period [para 14].

[15] At the hearing, acknowledging that the evidence was not perfect, the Owner suggested that the Registrar could take judicial notice of the fact that there was an ongoing pandemic when the evidence was filed, from which it could be inferred that there may have been some difficulty “putting together” the evidence. I note, however, that in his affidavit of record, Mr. Roberts does not attest to any difficulty in compiling the Owner’s evidence in this case.

[16] In any event, the Owner submitted that reasonable inferences could be drawn from the evidence as a whole, such that the Roberts Affidavit is sufficient to demonstrate use of the Mark, emphasizing in particular “use” by export within the meaning of section 4(3) of the Act.

[17] First, with respect to section 4(1) of the Act, while the Owner submitted that it is not necessary to submit invoices or the like in a section 45 proceeding, it remains that there is simply no evidence of any transfers in the normal course of trade or otherwise of the goods in Canada during the relevant period as required. In this respect, I agree with the Requesting Party that even a generous read of the evidence would indicate that, at best, the Owner sold the goods outside of Canada and had “aspirational plans” within Canada, which may or may not have come to fruition. In any event, absent details of such transfers, it would merely be speculative as to whether the Mark would have been associated with such goods at the time of any transfer.

[18] Accordingly, I am not satisfied that the evidence demonstrates use of the Mark in association with the registered goods within the meaning of sections 4(1) and 45 of the Act.

[19] With respect to use by export pursuant to section 4(3) of the Act, the Owner pointed to the evidence referencing sales and/or installation of iMirror panels in other countries [e.g., the Roberts Affidavit at para 11, Exhibit H].

[20] However, even if I were to give some weight to the relevant exhibits (which are otherwise mostly hearsay in nature), there remains insufficient evidence from which to infer that the Owner used the Mark by way of export of the subject goods during the relevant period. In this respect, while the undated photographs appearing at Exhibits C and E indicate that the goods are capable of digitally displaying the Mark on their screens, there is no evidence that the Mark was so displayed or otherwise marked on the goods or their packaging at the time of any export. In any event, although the Owner appears to be a Calgary-based company, there is no evidence that the goods are or were actually manufactured in Canada such that it would be reasonable to infer that goods sold to other countries would necessarily have originated from and been exported from Canada.

[21] In view of the foregoing, I am also not satisfied that the Owner has demonstrated use of the Mark in association with the registered goods within the meaning of sections 4(3) and 45 of the Act.

[22] Furthermore, there is no evidence of special circumstances excusing non-use of the Mark.

**DISPOSITION**

[23] In view of all of the foregoing, pursuant to the authority delegated to me under section 63(3) of the Act, and in compliance with the provisions of section 45 of the Act, the registration will be expunged.

---

Andrew Bene  
Member  
Trademarks Opposition Board  
Canadian Intellectual Property Office

# Appearances and Agents of Record

**HEARING DATE:** 2023-05-30

## **APPEARANCES**

**For the Requesting Party:** Mark Biernacki

**For the Registered Owner:** Andy Chow

## **AGENTS OF RECORD**

**For the Requesting Party:** Smart & Biggar LP

**For the Registered Owner:** MLT Aikins LLP